

**REMARKS**

**The Amendments**

Claim 1 is amended to incorporate part of the substance of claim 5 therein. Claims 4, 6 and 7 are amended for formal matters. New claims 11-13 are added which are supported, for example, at page 2, lines 26-36, page 3, lines 27-31, page 4, lines 15-17, and page 4, lines 19-26. For new claims 12 and 13, the disclosure makes clear that the pearlescent pigment and the laser sensitive pigment both provide laser absorption and it is the combination thereof that provides the advantageous laser marking properties of the invention.

To the extent that the amendments avoid the prior art or for other reasons related to patentability, competitors are warned that the amendments are not intended to and do not limit the scope of equivalents which may be asserted on subject matter outside the literal scope of any patented claims but not anticipated or rendered obvious by the prior art or otherwise unpatentable to applicants. Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

**The Rejection under 35 U.S.C. § 112, First Paragraph**

The rejection of claims 4-6 under 35 U.S.C. § 112, first paragraph, is respectfully traversed. It would be well within the skill of one of ordinary skill in the art to determine, based on their knowledge of pigments and/or by conducting only routine experimentation, which metal oxide coated pigments will exhibit a pearlescent effect and which will not. Whether or not such a pigment exhibits a pearlescent effect is apparent to one of ordinary skill in the art merely by observation and the particular metal oxide coating(s) and its thickness will determine whether the optical properties of the pigment are such that the

pearlescent effect is observed. Only routine experimentation, if any, for this art would be required to make the invention. Such routine experimentation is not undue and does not run afoul of the enablement requirement. It is further pointed out that pigments of mica coated with one or more metal oxides which have no pearlescent effect were known in the art and commercially available; see, e.g., page 5, lines 13-25, of the disclosure and the Solms reference discussed below. Thus, such pigments were clearly available to one of ordinary skill in the art. Thus, the rejection should be withdrawn.

#### **The Obviousness-Type Double Patenting Rejection**

The obviousness-type double patenting rejection of claims 1-10 over claims 1-17 of U.S. Patent No. 6,545,065 to Solms is respectfully traversed.

The claims of Solms all require that the laser-markable plastic contain at least one inorganic platelet-form substrate. It is clear from the Solms disclosure that this term is directed to an uncoated inorganic platelet material which provides laser absorption. The instant claims do not require such a component. See amended claim 1 more precisely defining the laser-sensitive pigment as “mica coated with one or more metal oxides, the nature and thickness of the coating(s) on the mica being such that no pearlescent effect occurs.” This is one distinction of the claimed subject matter.

The instant claims recite a component of “mica coated with one or more metal oxides, the nature and thickness of the coating(s) on the mica being such that no pearlescent effect occurs.” The Solms claims recite a “non-lustrous metal oxide-coated mica pigment.” But such is not a required component of the Solms claims, i.e., it is merely an alternative to the pearl luster pigment. Thus, Solms clearly does not recognize the advantageous combination of a pearl luster pigment and a non-lustrous (i.e., non-pearlescent) coated mica pigment.

Solms, as further discussed below, teaches their alternative use not their advantageous combination. This is another distinction of the claimed subject matter.

For these reasons, it is urged that the claimed subject matter is patentably distinct and the obviousness-type double patenting rejection should be withdrawn.

**The Rejections under 35 U.S.C. § 102(e)**

The rejection of claims 1-10 under 35 U.S.C. § 102(e), as being anticipated by Kniess (U.S. Patent No. 6,291,551) or Solms (U.S. Patent No. 6,545,065) is respectfully traversed.

Kniess discloses a pigment mixture containing anthracene or pentaerythritol and an effect pigment, which effect pigment may be a pearl luster pigment. See, e.g., col. 3, lines 22-26.

The amendment to claim 1 above is believed to render the anticipation rejection over Kniess moot. The claims now recite the combination of a pearlescent pigment and a laser-sensitive pigment, wherein the laser-sensitive pigment is composed of mica coated with one or more metal oxides, the nature and thickness of the coating(s) on the mica being such that no pearlescent effect occurs. Kniess provides no specific description of a pigment having such a combination. Such a specific description is necessary to support anticipation; see, e.g., In re Kollman et al, 201 USPQ 193 (CCPA 1979). Thus, the rejection under 35 U.S.C. § 102 should be withdrawn.

Further, Kniess does not even generally suggest such a combination. While Kniess generally discusses coated mica pigments and pearl luster pigments (see col. 3, lines 1-26), it discusses the pearl luster pigments as a category of such coated mica pigments. Even if Kniess generally contemplates coated mica pigments which are not pearl luster pigments, it never contemplates a combination pigment having both coated mica non-pearl luster

pigments and coated mica pearl luster pigments. In any event, it is noted that, as a commonly assigned 35 U.S.C. § 102(e) reference, Kniess cannot be used for a 35 U.S.C. § 103 rejection in view of 35 U.S.C. § 103(c).

Solms generally recites a pigment having “a mixture of pearl luster pigments and/or non-lustrous metal oxide-coated mica pigments and inorganic platelet-form substrates.” Despite the use of the “and/or” term as possibly generically encompassing mixtures with both pearl luster pigments and/or non-lustrous metal oxide-coated mica pigments, there is no explicit or direct disclosure of any pigment having such a combination. For example, in the 8 examples of the patent, the compositions contain, together with the Iriodin LS 800 uncoated mica, either an Iriodin pearlescent pigment or an Iriodin LS 810 non-lustrous coated mica pigment. But they never contain both such types of pigments. As made clear in In re Kollman cited above, a mere broad generic disclosure without any specific direction as to the specific element necessary to provide an anticipation is not an anticipatory disclosure. In other words, such a broad generic disclosure does not “describe” an embodiment therein in accordance with 35 U.S.C. § 102. For example, if such a reference were anticipatory, it would not be possible to prove nonobviousness for selection inventions within a generic disclosure. Such is not the state of the law. Furthermore, despite its merely generic disclosure, Solms fails to disclose or suggest the advantages of the combination pigments discovered by applicants. Since Solms discloses these components as alternatives, instead of required together, it obviously fails to recognize any particular advantage in the combination. For example, the reference fails to disclose or suggest the advantageous laser marking ability in transparent or translucent plastics discovered by applicants in such combination; see, e.g., page 3, lines 1-25, of the instant specification. Accordingly, Solms also fails to anticipate the instant claims and the rejection under 35 U.S.C. § 102 should be withdrawn.

**The Rejection under 35 U.S.C. § 103**

The rejection of claims 1-10 under 35 U.S.C. § 103, as being obvious over Babler (U.S. Patent No. 5,075,195) in view of Koops (U.S. Patent No. 6,444,068) is respectfully traversed.

It would appear from the statement of the rejection that this rejection is rendered moot by the above amendment to claim 1. The rejection did not address or allege that the references rendered obvious a pigment composition containing a combination of a pearlescent pigment and a laser-sensitive pigment of mica coated with one or more metal oxides where the nature and thickness of the coating(s) on the mica laser-sensitive pigment being such that no pearlescent effect occurs, as recited in current claim 1. Although it is believed the rejection is rendered moot, the references will be briefly addressed for completeness purposes.

Babler discloses a pigment for laser marking of plastics which contains molybdenum disulfide as a radiation absorber. Babler recites a wide variety of additional additives. Among those listed are pearlescent effect pigments and mica as a filler. There is no disclosure or suggestion of the additive use of a laser-sensitive pigment of mica coated with one or more metal oxides which does not have a pearlescent effect. Particularly, there is certainly no disclosure or suggestion of the combined use of a pearlescent pigment together with a laser-sensitive pigment of mica coated with one or more metal oxides which does not have a pearlescent effect. There is also, obviously, no suggestion of any advantage to be gained in laser markability by such combination.

Koops was cited for its disclosure that pearlescent pigments were useful in a glass coating for providing colored laser markings. Even if this teaching is considered applicable to the plastics compositions of Babler, such combination would not result in or suggest the


claimed invention. Koops also fails to disclose anything regarding the combined use of a pearlescent pigment and a laser-sensitive pigment of mica coated with one or more metal oxides which does not have a pearlescent effect.

Accordingly, the combined teachings of the prior art, considered as a whole, fail to render the claimed invention obvious to one of ordinary skill in the art. Thus, the rejection under 35 U.S.C. § 103 should be withdrawn.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

  
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